

Appl. No. 09/674,052
Atty. Docket No. CM1778Q
Amdt. dated September 29, 2004
Reply to Office Action of June 29, 2004
Customer No. 27752

REMARKS

Claims 1 and 3-12 are pending in the present application. No additional claims fee is believed to be due.

Claim 5 has been amended to correct an antecedent basis issue. Support for this amendment can be found in claim 5 as originally filed.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 103(a) Over Gilman et. al

The Office Action has rejected claims 1 and 3-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,437,653 issued to Gilman et. al. Applicants respectfully traverse the rejection by the Office Action because the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* The Office Action has failed to establish a *prima facie* case of obviousness because there is no motivation to modify the cited reference and the cited reference fails to teach or suggest all of the claim limitations of the claimed invention.

First, there is no motivation to modify the Gilman et. al reference. The Office Action states that the Gilman et. al reference does not teach that the second material has a higher hydrophilicity than the first material as is recited, in part, in claim 1. (Office Action page 4, lines 6-7). However, the Office Action alleges that because the Gilman et. al reference teaches suitable materials for the first material which are hydrophobic and teaches that the second material can be an absorbent layer, that it would have been obvious to one of ordinary skill in the art to modify the second material such that it had a higher hydrophilicity than the first material. (See Office Action page 4, lines 8-13).

The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*citing* In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir.

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1990)). In the Mills case, the claimed invention was directed toward an apparatus for producing an aerated cementitious composition. *In re Mills*, 916 F.2d at 681. The composition was created by driving air into an output pump at a rate that was greater than the feed rate of the pump. *Id.* The cited prior art reference taught that the speed of the prime mover could be controlled by a variable speed transmission. *Id.* at 682. The court found that the teachings of the prior art reference were inadequate to establish a *prima facie* case of obviousness because the cited reference did not require the output pump to run at the claimed speed. *See Id.*

Similarly, the Gilman et. al reference teaches that the absorbent layer 20 could be constructed of the same hydrophobic material as the cover 12. (col. 4, lines 47-50). The Gilman et. al reference further teaches that the absorbent layer 20 and the cover 12 are preferably made of a different material or at least has different properties than the cover 12. (col. 4, lines 51-53). The Gilman et. al reference further teaches that the cover 12 and the absorbent layer 20 comprise apertures 18 and 26, respectively. (col. 5, lines 9-11). "The apertures 18 and 26 formed through the cover 12 and the absorbent layer 20 provide pathways which allow for a rapid movement of body fluid downward into the primary absorbent 22 and 24." (col. 5, lines 36-39). So even though the Gilman et. al reference teaches that the absorbent layer 20 preferably has different properties from those of the cover 12, the Gilman et. al reference does not require or suggest that the absorbent layer 20 has a higher hydrophilicity than the cover 12.

Because the Gilman et. al reference does not require or suggest that the absorbent layer 20 have a higher hydrophilicity than that of the cover 12, there is no motivation to make the suggested modification increasing the hydrophilicity of the absorbent layer 20 to above that of the cover 12.

Second, the Gilman et al. reference fails to teach or suggest all of the claim limitations of the claimed invention. The Office Action asserts that the claim limitation found in claim 1 which recites, in part, "wherein a plurality of fibers of said first material and a plurality of fibers of said second material are substantially fused together about the apertures," is a product by process limitation. Because the Office Action considers the above phrase a product by process limitation, only the end product of the process is given patentable weight.

The Gilman et. al reference teaches a product that has apertures, wherein during "the aperturing process, some of the fibers 28 are broken and pushed down into the absorbent layer 20 by the penetration of the aperturing pins. (col. 5, lines 43-45). "As these broken fibers are pushed down into the absorbent layer 20, they tend to embed themselves in the fibers of the absorbent

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layer 20." (col. 5, lines 45-48). The Gilman et. al reference also teaches, that the embedding of these broken fibers is "important because it prevents the fibers 28, which can be relatively stiff fibers, from moving upward as the aperture pins are withdrawn" thereby eliminating the presence of course fibers. (col. 5, lines 47-52).

In contrast, the specification, with reference to Figure 5, teaches a product wherein a first and second material can be simultaneously apertured and bonded together. (page 15, lines 12-15). The first and second material can be passed through rollers 254 and 260 which are heated above the melting points of the first and second materials. (page 15, lines 12-16). Because the rollers 254 and 260 are heated above the melting temperatures of the first and the second materials, as the first and second materials pass through a nip created by the rollers 254 and 260, at least a portion of the apertures perimeter is fused. (page 15, lines 14-17).

Moreover, as defined within a dictionary, the term "embed" is defined as "[t]o fix firmly in a surrounding mass" or "[t]o enclose snugly or firmly." (American Heritage College Dictionary (Houghton Mifflin Co. 4th ed. 2002)). In contrast, the term "fused" means "[t]o liquefy or reduce to a plastic state by heating; melt" or "[t]o mix together by or as if by melting; blend." (*Id.*). Thus, by substantially fusing the fibers together about the apertures of the first and second material, the fibers are melted together to become a portion of another fiber. In contradiction, a broken fiber does not become a part of another fiber, it is merely mechanically entangled with other fibers such that the fiber becomes trapped. So, fused fibers are very different from fibers which are embedded.

Applicants assert that even if the claim limitation recited above is a product by process limitation, the substantial fusing of fibers is very different from breaking fibers and embedding them in a layer below thereby rendering the final product different from that taught in the cited reference. Therefore, the Gilman et. al reference does not teach or suggest all of the claim limitations of amended claim 1. Namely, the Gilman et. al reference fails to teach or suggest "a plurality of fibers of said first material and a plurality of fibers of said second material are substantially fused together about the apertures," as recited, in part, in amended claim 1.

Because there is no motivation to modify the Gilman et. al reference and because the Gilman et. al reference does not teach all of the claim limitations of claim 1, the Office Action has not established a *prima facie* case of obviousness against claim 1. Therefore claim 1 is nonobvious over the cited reference and is therefore patentable. In addition, because claims 3-12 depend from claim 1, the cited reference also does not teach all the claim limitations of claims 3-

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12. Consequently, the Office Action has not established a *prima facie* case of obviousness against claims 3-12. Thus, claims 3-12 are also patentable.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 3-12.

Respectfully submitted,

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